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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,990	12/31/2003	Teddy E. Morelock	1472-001	5479

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JONDLE & ASSOCIATES P.C.  
9085 EAST MINERAL CIRCLE  
SUITE 200  
CENTENNIAL, CO 80112

EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT PAPER NUMBER

1638

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/750,990

Applicant(s)

MORELOCK, TEDDY E.

Examiner

Keith O. Robinson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☒ Claim(s) 1,6,22,23 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Claim Objections*

Claims 1, 6, 22, 23, and 28 are objected to for their inclusion of blanks (\_\_\_\_). It is assumed that the blanks will be replaced by an ATCC Accession Number.

### *Claim Rejections - 35 USC § 112, first paragraph*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are drawn to seed of cowpea line 951135, method of using said seed, and parts thereof.

Since the seed is essential to the claimed inventions, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the plant is not so obtainable or available, the requirements of 35 U.S.C. 112 may be satisfied by a deposit of the plant. The specification does not disclose a repeatable process to obtain the plant and it is not apparent if the plant is readily available to the public. Thus, a deposit is required for enablement purposes. A deposit

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of 2500 seed of each of the claimed embodiments is considered sufficient to ensure public availability. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific strain has been deposited under the Budapest Treaty and that the strain will be irrevocably and without restriction or condition released to the public upon the issuance of a patent, would satisfy the deposit requirement herein.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 C.F.R. 1.801-1.809, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

- (a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- (c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer;
- (d) a test of the viability of the biological material at the time of deposit (see 37 C.F.R. 1.807) and,
- (e) the deposit will be replaced if it should ever become inviable.

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It is acknowledged that Applicant has provided a deposit statement; however, this statement is incomplete (see page 29 of the specification). There is no indication in the specification as to the duration that the deposit will be maintained, the viability of the biological material at the time of deposit, or the replacement of inviable seeds.

Applicant is asked to make the required corrections.

Claims 8 and 9 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The claims are broadly drawn to hybrid cowpea seed and the seed derived from said hybrid cowpea seed.

The specification does not describe the other cowpea plant or plants that are to be crossed with 951135 nor is there a description of their genetic, morphological, and/or physiological background. It is known in the art that any plant derived from the crossing of two different plants will produce an F1 hybrid plant that is heterozygous at all loci; therefore, the hybrid plant will contain 50% of the alleles from the 951135 cowpea plant and 50% of the alleles from the other cowpea plant. The 951135 cowpea plant, as well as its seeds and parts thereof, is the claimed invention, so a plant that contains only 50% of the alleles of the 951135 cowpea plant is not the same as the claimed 951135 cowpea plant, which would have 100% of its alleles. Furthermore, claim 9 reads on an additional generation of outcrossing to a non-951135 cowpea parent so that seed with

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as little as 25% of the 951135 alleles would be produced. Moreover, the genetic, morphological, and/or physiological characteristics of the claimed hybrids are not described in the specification. Since the claimed invention is derived from the crossing of 951135 with any cowpea plant, there could conceivably be hundreds of hybrids, each with different genetic, morphological, and/or physiological characteristics due to each having different "other" parents and the specification does not describe these hundreds of hybrids.

The Federal Circuit has recently clarified the application of the written description requirement. The court stated that a written description of an invention "requires a precise definition, such as by structure, formula, [or] chemical name, of the claimed subject matter sufficient to distinguish it from other materials". *University of California v. Eli Lilly and Co.*, 119 F.3d 1559, 1568; 43 USPQ2d 1398, 1406 (Fed. Cir. 1997). The court also concluded that "naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not description of that material". *Id.* Further, the court held that to adequately describe a claimed genus, Patent Owner must describe a representative number of the species of the claimed genus, and that one of skill in the art should be able to "visualize or recognize the identity of the members of the genus". *Id.*

See MPEP Section 2163, page 156 of Chapter 2100 of the August 2001 version, column 2, bottom paragraph, where it is taught that

[T]he claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function

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and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequence described only by a functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence.

Given the failure of the specification to describe the claimed plant, methods of using it are also inadequately described. Accordingly, one skilled in the art would not have recognized Applicants to have been in possession of the claimed invention. See the written description guidelines published in Federal Register/ Vol. 66, No. 4/ Friday January 4, 2001/ Notices: pp. 1099-1111.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are broadly drawn to hybrid cowpea seed and seed derived from said hybrid cowpea seed.

The specification does not give any guidance as to the other cowpea plant or plants that are to be crossed with 951135 nor is there a description of their genetic, morphological, and/or physiological background. It is known in the art that any plant derived from the crossing of two different plants will produce an F1 hybrid plant that is heterozygous at all loci; therefore, the hybrid plant will contain 50% of the alleles from the 951135 cowpea plant and 50% of the alleles from the other cowpea plant. The 951135 cowpea plant, as well as its seeds and parts thereof, is the claimed invention,

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so a plant that contains only 50% of the alleles of the 951135 cowpea plant is not the same as the claimed 951135 cowpea plant, which would have 100% of its alleles. Furthermore, claim 9 reads on an additional generation of outcrossing to a non-951135 cowpea parent so that seed with as little as 25% of the 951135 alleles would be produced. Moreover, the genetic, morphological, and/or physiological characteristics of the claimed hybrids are not described in the specification. Since the claimed invention is derived from the crossing of 951135 with any cowpea plant, there could conceivably be hundreds of hybrids, each with different genetic, morphological, and/or physiological characteristics due to each having different "other" parents and the specification does not describe these hundreds of hybrids in terms of their traits, or provide any guidance regarding their use and therefore, it would not enable one skilled in the art to make and/or use the claimed invention.

While the introgression of single genes into plants for a desired trait is desirable and is well within the level of one skilled in the art, the state of the art teaches that it is unpredictable whether a gene or genes for conferring a phenotype in one plant genetic background may be transferred into the genetic background of another plant to confer the phenotype in said different plant. For example, Hunsperger et al (US Patent No. 5,523,520) disclosed a specific gene trait in the genetic background of one plant which has been introgressed into the genetic background of another plant of the same species, that did not result in the expected transfer gene trait (see, column 3, lines 26-46). Kraft et al (Theor. Appl. Genet. 101:323-326, 2000) teach that linkage disequilibrium effects and linkage drag prevent the making of plants comprising a single



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transferred trait and that effects are unpredictably genotype specific and loci dependent in nature. Kraft et al teach that linkage disequilibrium is created in breeding materials when several lines become fixed for a given set of alleles at a number of different loci, and that very little is known about the plant breeding material, and therefore, is an unpredictable effect in plant breeding (see, page 323, column 1, lines 7-15). Eshed et al (Genetics 143:1807-1817, 1996) teach that epistatic genetic interactions from the various genetic components comprising contributions from different genomes may affect quantitative traits in a genetically complex and less than additive fashion (see, pages 1815-1816). Marfo et al (Crop Sci. 32:912-918, 1992) teach that environmental effects play a role in heat tolerance in cowpea, causing the low heritability (see page 917, first column, second paragraph to second column, end of second paragraph). Singh et al (Crop Sci. 33:70-72, 1993) teach that epistasis does occur in the inheritance of quantitative traits, namely Alectra resistance, of cowpea (see page 71, Table 1; page 71, second column, second paragraph to page 72, first column, end of first paragraph; and page 72, Table 2 and Table 3).

Neither the instant specification nor the prior art provides evidence that such linkage disequilibrium, linkage drag, or epistatic effects are not common in cowpea breeding materials, such that one or more genes can be transferred from one genetic background to another, wherein the resultant cowpea progeny would either express the desired trait or maintain all of the other desirable 951135 genes and traits.

Given the lack of guidance in Applicant's specification regarding a multitude of non-exemplified hybrids, single gene conversions, the unpredictability of transferring

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said genes, and the breadth of the claims, one skilled in the art would not be able to make and/or use the inventions claimed without undue experimentations.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Kline et al (HortScience 32(5):945-946, 1997). The claim reads on F2 progeny, including segregating progeny with 100% of non-951135 alleles; therefore, the claim reads on any cowpea plant or seed with any alleles at any locus. The claimed method of making the plant or seed would not confer a unique property to the resultant non-951135 cowpea plant or seed.

Kline et al teach a cowpea plant (see pages 945-946).

The cowpea plant or seed taught by the prior art differs from the claimed cowpea plant or seed in their method of making, namely by the use of different starting material. However, the method of making the claimed cotton plant would not distinguish it from the prior art cotton plant. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the

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product fails to distinguish the two products. See *In re Best*, 195 USPQ 430, 433 (CCPA 1997), which teaches that where the prior art product seems to be identical to the claimed product, except that the prior art is silent as to a particularly claimed characteristic or property, then the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention.

Claims 1-8 and 10-29 are deemed free of the prior art, given the failure of the prior art to teach or suggest an exemplified cowpea plant which possesses a unique genetic complement and unique collection of traits as that of cowpea line 951135, or methods of using said cowpea line.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, Ph.D. can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 21, 2004

KOR

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180

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